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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP TED KORTUM

Appeal 2008-5184
Application 09/847,045
Technology Center 3600

Decided:¹ February 13, 2009

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

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The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3-8, 10-16, and 18-20 which are all the pending claims remaining in the case. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed to a process and kit for DSL self-installation wherein the entire installation process is described within a single instruction manual. (Specification, 4:15-21). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A digital subscriber line self installation kit comprising:

a digital subscriber line modem;

at least one digital subscriber line filter;
a computer readable medium whose contents comprise computer readable connection software code; and

at most one instruction manual which describes a unified installation process which provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code, wherein the instruction

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manual requires no operating system selection by a user and wherein the at most one instruction manual corresponds to an operating system of the user.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

SBC Global Network DSL: Customer Self Install; the Internet printout of SBC Global Network-Digital Subscriber Line (<http://web.archive.org>) August 2000 (hereinafter the “SBC Global” reference).

Using Your Gateway PC Guide; Guide Instruction Manual (1997) (hereinafter the “Gateway PC” reference).

The following rejections are before us for review:

1. Claims 1, 3-8, 10-16 and 18-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over the SBC Global and Gateway PC reference.

THE ISSUE

At issue is whether the Appellant has shown that the Examiner erred making the aforementioned rejections.

This issue turns on whether it would have been obvious to modify the SBC Global reference to include an instruction manual as disclosed by the Gateway PC reference.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence²:

- FF1. The SBC Global reference is directed to a customer self-installing a DSL service system (Page 1).
- FF2. The SBC Global reference discloses that the equipment includes a DSL modem (Page 4, last paragraph).
- FF3. The SBC Global reference discloses that microfilters are used in the self-install (Page 1, third paragraph).
- FF4. The SBC Global reference discloses that an operating system and hard disk space are used (pages 5 and 8-9) in the system which shows that software is used in installing the program.
- FF5. The Gateway PC reference discloses an instruction manual for assembling a personal computer.
- FF6. It is taken as well known that a variety of devices include a single instruction manual for assembling a kit or system.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

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subject matter pertains.”” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

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with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Appellant argues as a group the rejection of claims 1, 3-8, 10-16 and 18-20 under 35 U.S.C. § 103(a) as unpatentable over the SBC Global and Gateway PC references. We select claim 1 as representative of this group and the remaining claims stand or fall with claim 1. See 37 C.F. R. § 41.37 (c)(1)(vii) (2007).

The Appellant argues that the rejection of claim 1 is improper because “The SBC Document also does not disclose or suggest that the at most one instruction manual provides instructions to install all of the digital subscriber line modem, the at least one digital line filter, and the computer readable connection software” (Br. 4). The Appellant further argues that the Gateway PC reference “fails to fill the gaps” (Br. 5). Specifically, the Appellant argues that the Gateway PC reference guide is for a personal computer and describes information for connecting a keyboard, mouse, speakers, etc (Br. 5). The Appellant argues that the Gateway PC reference does not disclose a digital subscriber line modem and digital subscriber line filter (Br. 5). The Appellant argues that if a modem was ordered that it was ordered with the computer and pre-installed (Reply Br. 2).

The Examiner has not asserted that the SBC Global reference teaches the use of an instruction manual (Ans. 4). The Examiner has determined that

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the Gateway PC reference shows instructions on how to assemble the various components of a computer. The Examiner's position is that it would have been obvious to modify the SBC Global reference to include an instruction manual to allow the customer to have the necessary diagrams and installation steps to simplify installation of the system (Ans. 4). The Examiner states that while the Gateway PC document does not specifically refer to a DSL modem, it does provide detailed instructions of how to connect various parts of an electronic system and it would have been obvious to include a similar manual in the SBC Global reference to help a customer in the installation steps (Ans. 4-5). The Examiner further states that it is common practice to include instruction manuals with even simple mechanical or electrical devices (Ans. 8).

We agree with the Examiner. In *KSR*, the Supreme Court rejected the Federal Circuit's rigid application of its teaching, suggestion, motivation test in favor of an expansive and flexible approach. *Id.*, 127 S. Ct. at 1739. The Supreme Court noted that often, it will be necessary

to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id., 127 S. Ct. at 1740-41. The Supreme Court also noted that "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*,

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127 S. Ct. at 1741. Here, the SBC Global reference shows a DSL system for self installation including a DSL modem, DSL filter, and software code (FF1, FF2, FF3) and the Appellant has not disputed this. The Gateway PC reference discloses an instruction manual for assembling a personal computer (FF5). A variety of other devices also include a single instruction manual to aid in assembling a device (FF6) and the Gateway PC reference is an example of such an instruction manual. Instruction manuals simply provide a user assistance in assembling together any kit, product, or system with instructions or diagrams specific to that system. One of ordinary skill in the art could readily infer that it would be beneficial to create an instruction manual specifically for the SBC Global DSL system to aid in assembly as taught by the Gateway PC reference and known in the art. We therefore conclude that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the SBC Document to include an instruction manual specific to that system for the benefit of assisting a person in assembling the device as taught by the Gateway PC reference. For the above reasons the rejection of claims 1, 3-8, 10-16 and 18-20 under 35 U.S.C. § 103(a) as unpatentable over the SBC Global and Gateway PC references is sustained.

CONCLUSIONS OF LAW

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 1, 3-8, 10-16 and 18-20 under 35 U.S.C. § 103(a) as unpatentable over the SBC Global and Gateway PC references.

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DECISON

The Examiner's rejection of claims 1, 3-8, 10-16 and 18-20 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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